

REMARKS

In the Office Action of June 11, 2008, the specification was objected to because the abstract did not follow the suggested language and format for an abstract of the disclosure. In addition, claims 1-9 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Applicant's admitted prior art (hereinafter "AAPA") in view of U.S. Patent Number 4,646,327 (hereinafter "Kojima et al."). Furthermore, claims 10 and 11 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over AAPA and Kojima et al. in view of U.S. Patent Number 4,118,739 (hereinafter "Umehara").

With respect to the abstract of the disclosure, Applicant has amended the abstract to remove the term "means" from the abstract. As such, Applicant respectfully requests that the objection to the specification be withdrawn.

With respect to the claim rejections, Applicant has amended the dependent claims 10 and 11 to more clearly distinguish the claimed invention from the cited references. As amended, the dependent claims 10 and 11 are not obvious in view of AAPA, Kojima et al. and Umehara, as explained below. Furthermore, Applicant respectfully asserts that the independent claims 1 and 5 are not obvious in view of AAPA and Kojima et al., as also explained below. In view of the claim amendments and the following remarks, Applicant respectfully requests the allowance of the independent claims 1 and 5, as well as the dependent claims 2-4 and 6-11.

A. Patentability of Independent Claims 1 and 5

The independent claims 1 and 5 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over AAPA and Kojima et al. However, the Office Action has failed to establish a *prima facie* case of obviousness for the independent claims 1 and 5. Thus, the independent claims 1 and 5 are not obvious in view of AAPA and Kojima et al.

The Office Action asserts on page 4 that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify Applicant’s background of invention as taught by Kojima to correct the distortions in the communication system (see column 1, lines 1-18).” Thus, the Office Action has apparently alleged that it is obvious to include the waveform shaping apparatus 11 and the LPF 13 of the data transmitting-receiving system of Kojima et al. in the data carrier 1 of AAPA to derive the claimed invention, as recited in the independent claims 1 and 5. Applicant respectfully disagrees.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In the data carrier 1 of AAPA, the data signal DS is used to control the modulation means 11 so that the signal S is generated by the data carrier 1. As described on page 5, lines 9-11, of the current application, the data signal DS “is digital in nature and, accordingly, essentially has either a first voltage value corresponding to the reference potential GND or a second voltage value corresponding to the supply voltage V.” Thus, the modulation means 11 needs a signal with first and second voltage values, such as the data signal DS, to produce the desired output signal S.

The waveform shaping apparatus 11 of the data transmitting-receiving system of Kojima et al. processes input data and produces output signal, e.g., the output signal of Fig. 3F. As illustrated in Fig. 3F, the output signal includes more than two levels, e.g., levels -1, 0, 1, 2 and 3. Thus, if the data carrier 1 of AAPA is modified to include the waveform shaping apparatus 11 and the low-pass filter 13 of Kojima et al., the signal applied to the modulation means 11 of the data carrier 1 of AAPA would have more than two levels and the modified data carrier will be rendered unsatisfactory for its intended purpose, i.e., to produce the desired output signal S. That is, the output signal S will not be produced by the modified data carrier using the output signal from the waveform shaping apparatus 11 of Kojima et al. on the modulation means 11 of the data carrier 1 of AAPA. Thus, the independent claims 1

and 5 are not obvious in view of AAPA and Kojima et al. As such, Applicant respectfully requests that the independent claims 1 and 5 be allowed.

B. Patentability of Dependent Claims 2-4 and 6-11

Each of the dependent claims 2-4 and 6-11 depends on one of the independent claims 1 and 5. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicant submits that these dependent claims are allowable for the same reasons as their respective base claims. Furthermore, the dependent claims may be allowable for additional reasons.

As an example, the amended dependent claim 10 recites “*the modulation means includes a transistor with a control terminal, and the signal-edge influencing means includes a resistor connected directly to the control terminal of the transistor of the modulation means and a capacitor connected directly to the control terminal of the transistor of the modulation means and ground,*” which is not disclosed in AAPA, Kojima et al. and Umehara. In particular, the resistor 43 and the capacitor 42 of the cited reference of Umehara are not connected directly to any control terminal of a transistor of a modulation means. Thus, the amended dependent claim 10 is not obvious in view of AAPA, Kojima et al. and Umehara. These remarks are also applicable to the amended dependent claim 11, which recites limitations similar to those of the amended dependent claim 10.

Applicant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,

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